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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,043	04/13/2004	Thomas J. Maginot	22220-09031	6032

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EXAMINER
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PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/824,043

Applicant(s)

MAGINOT, THOMAS J.

Examiner

Paul B. Prebilic

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 1-6 is/are allowed.  
6) ☒ Claim(s) 7-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### ***Claim Objections***

Claims 7-10 are objected to because of the following informalities:

With regard to claims 7-10, on line 5 of claim 7, the claim language is grammatically awkward in that it contains serial prepositional phrases. The Examiner suggests inserting commas on either side of the new language so that the language is clearer. Appropriate correction is required.

### ***Terminal Disclaimer***

The terminal disclaimer filed on April 18, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,401,721 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Rejections Based Upon Prior Art***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kreamer (US 4,577,631) alone.

Kreamer anticipates the claim language where the incision into the body is considered inherent because a hole or opening into the femoral artery as shown by Kreamer is not naturally present; see Figures 8-10 and column 5, line 55 to column 7, line 2. The claimed step of anastomosis is considered met by Kreamer since the graft is adhesively attached to the inside of the vessel.

Alternatively, one may not consider the Kreamer adhesive attachment to be an anastomotic procedure as claimed. However, the Examiner asserts that it would have been at least obvious to form an end-to-end anastomosis since an anastomosis is merely a manner of connecting lumens together.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donaldson (US 2,935,068) in view of Sparks (US 3,710,777). Donaldson teaches that it was known to use bypass grafts to attach a number of different arteries; see the figures, especially Figure 3, where an aortic and femoral artery is attached as well as column 2, lines 11-16 and column 5, line 67 to column 6, line 16. However, Donaldson fails to teach inserting the graft through the incision upwardly along the aorta as claimed. Sparks teaches using a tunneling tube to instead a graft through tissue and form side-to-end anastomosis along an artery; see Figure 19 and column 3, line 2 to column 5, line 60. Therefore, it would have been prima facie obvious to one of ordinary skill to attach one end of the Donaldson graft to an aorta (i.e. an artery) and another blood vessel such as a femoral artery as taught by Donaldson by using the tunneling tube technique disclosed by Sparks. One would be motivated to use the Sparks technique in

Art Unit: 3738

order to avoid making a long incision (more invasive procedure), and for the same reasons that Spark uses the same.

***Allowable Subject Matter***

Claims 1-6 are allowed over the prior art of record.

***Response to Arguments***

Applicant's arguments filed April 18, 2005 have been fully considered but they are not persuasive.

Applicant argues that claim 7 is not met by Kreamer because he says "claim 7 has been amended to define the invention more specifically to include 'installing within the aorta through an opening the graft conduit in collapsed configuration', and 'anastomosing another end of the graft conduit outside the aorta to a blood vessel in the body'". However, upon reviewing claim 7, the Examiner again concluded that the claim language is read upon by Kreamer. Alternatively, it is at least clearly obvious. This is due to the fact that the opening is made in the artery below the aorta and the graft is then inserted, in a collapse condition, to a site in the aorta where it is attached. The other end of the graft is attached to the femoral artery where balloon (58) is located. In other words, the location outside the aorta is in the femoral artery.

In response to the argument that Donaldson in view of Sparks does not render the claim language obvious because Sparks does not teach an upwardly tunneling operation, the Examiner asserts that "upwardly" and "downwardly" are relative to how

Art Unit: 3738

the patient and/or surgeon is oriented. For this reason, this claim language does not render the claims patentable.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

Art Unit: 3738

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott Corrine can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilic  
Primary Examiner  
Art Unit 3738